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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,317	11/05/2001	Robert R. DeWitt	0412-P00912US3	4088
110	7590	08/08/2005	EXAMINER	
DANN, DORFMAN, HERRELL & SKILLMAN 1601 MARKET STREET SUITE 2400 PHILADELPHIA, PA 19103-2307			BUTLER, MICHAEL E	
			ART UNIT	PAPER NUMBER
			3653	

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,317

Applicant(s)

DEWITT

Examiner

Michael Butler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 11 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 and 44-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 17-25, 28-30 and 32-43 is/are rejected.
- 7) ☐ Claim(s) 26 and 31 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action, and apply to this and any subsequent Office Actions.

Priority

1. Applicants claim of priority as a CIP of application 09/160401 filed 9/26/98 and as a CIP 09/113869 filed 7/10/98 and as a CIP of 08/687704 filed 7/26/96 and 08666737 filed 5/17/96 and 09/655008 filed 09/05/2000.

Restriction

2. Applicant's election of invention II with traverse of the restriction requirement in the response of 3/11/2005 is acknowledged and made final.

3. Claims 10-16 and 1-9 and 44-58 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

4. The applicant argues the restriction requirement ought be withdrawn because the examiner will search common base claims in the search of groups I and II. However, the group I claims have the additional feature of a method for document sorting needing further search found in and hence qualifying for the earlier subclass 223. The Group III claims have the additional feature of a document removal apparatus and method for use requiring further search found in and hence qualifying for the earlier subclass 219.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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6. If an elected claim is found allowable, any withdrawn claims having all the allowable elements are subject to rejoinder or alternatively may be amended and rejoined to depend from allowable elected base claims.

Drawings

7. Applicants drawings filed 11/27/02 are acceptable.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 17-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens et al. '273 in view of Miller. Stevens et al. '273 discloses the major elements including:

serially feeding envelopes from an input bin (c5 L 1-2)
opening an envelope along at least one edge (c9 L 35-55)
presenting contents of the envelope for removal at an extraction station (c10 L 12-48)
holding the envelope at the extraction station while contents are removed from the envelope
feeding the contents to an imager and scanning the contents (c21 L 13-17)
removing the envelope from the extraction station after removal of the envelope contents (c 15 L 1-19; c10 L 12-48)
storing image data on a non-volatile storage medium (c12 L 40-65)
the envelope is pulled apart to expose the contents (c10 L 12-48)
verifying that all of the contents of the envelope have been removed (c10 L 12-48)
holding an envelope at a verifier while a subsequent envelope is held at the extraction station (c 13 L 1-31, system precludes passage of documents while retained document is in envelope as seen by gating of conveyors)

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scanning contents to obtain magnetic image data and optical image data of selected documents (c29 L 1-40)

analysis of the magnetic indicia and optical image data is corroborated to verify accuracy of the document (c21 L 14-59; c 22 L 22-40)

magnetic indicia is read to locate and read magnetic indicia and optical image data (c21 L 14-59; c 22 L 22-40)

determining transaction type and correlating image data with the transaction type (c 22 L 7-40)

the opening step is performed by cutting along at least one edge (c9 L 34-55)

documents are singulated to serially convey the documents through an imager (c16 L 1-10)

examining the removed contents to determine information regarding the contents and controlling the manner in which the contents are fed to the imager in response to the determined information (c 22 L 7-40)

the documents are sorted responsive to the determined information (c29 L 65-c30 L 40)

imager comprised multiple chutes in which documents are feed according to document type (c 22 L 7-40)

the removed documents are examined to determine information and auditory signals are provided to determine information & control processing of the contents (c21 L 14-59)

magnetically scanning at least one document to read magnetic indicia (c 22 L 7-40)

analyzing optical image data for at least one document to locate and read magnetic indicia (c21 L 14-59; c 22 L 22-40)

results of magnetically scanning and optically scanning documents are used to compare and locate magnetic indicia (c21 L 14-59; c 22 L 22-40);

(Re: cl 24) pulling one side of the envelope away while holding the other stationary to expose and remove the contents (c10 L 12-48; fig 7)

(Re: cl 27,32) non-volatile storage medium for receiving and storing image data (c12 L 40-65)

(Re: cl 28,33) optical imaging device for obtaining document image (c29 L 1-40)

(Re: cl 29,34) magnetic imaging device; transport controller automatically advances envelope away from extractor after content removal (c21 L 14-59; c22 L 22-40)

(Re: cl 37) storing image on non volatile memory (c12 L 40-65)

(Re: cl 38) determining whether transaction is extracted and controlling envelope advance premised upon that determination (c13 L 1-31)

(Re: cl 39) scanning for optical image (c29 L 1-40)

(Re: cl 40) scanning for magnetic image (c21 L 14-59; c22 L 22-40)

(Re: cl 41) magnetic and optical scanning of image and verifying accuracy of image (c21 L 14-59; c22 L 22-40)

(Re: cl 42) feeding document to an input nip (c10 L 12-48; fig 7).

Stevens et al. '273 further teaches the modularity and interchangeability of the component subsystems, particularly of the extractor (c5 L 1-5).

Miller et al. discloses a semi-automated document processing system in which the automated the document is manually removed by an operator from a cut envelope (c7 L 46-53;c1 L 36-39). It would have been obvious at the time of the invention to omit the automated document extractor and remove the document from the envelope because removal saves the capital cost associated with the automated extractor and provides a reliable approach to document removal verification and manual operation of steps helps in repair, upgrade, and trouble shooting as taught by Miller et al. and thereby come up with the instant claimed invention.

Allowable Subject Matter

10. Claims 26 and 31 are objected to as being dependent claims premised upon a rejected base claim but would be allowed if the re-written in independent form or if the limitations of an allowable claim were incorporated within the independent base claim from which this claims depend or if re-written premised upon dependence from an otherwise allowable base claim.

Response to Arguments

11. Applicant's argument that the Stevens '577 patent is in the chain of priority of the instant application is persuasive in removing that reference from the set of available prior art.

The applicant's arguments regarding Stevens '273 have been fully considered but they are unpersuasive in overcoming the rejections. It would be obvious to one of ordinary skill in the art to use the teachings of Stevens '273 and reduce the level of technology and perform a task

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manually. Certainly machine breakdowns, repair, upgrade, and trouble shooting of portions of the system are going to result in occasions wherein the device of Stevens '273 will need have remittances removed by hand and troubleshooting will certainly involve situations in which a device needs have tasks performed by hand.

Applicant seems to be misconstruing the combining of hardware as also precluding the combining of elementary teachings from the reference.

Further noted is that applicant has admitted a lack of patentable distinction in manual removal in view of automated removal by his having contradicted the contention that manual document removal from an envelope is unobvious from automated document removal in his traversal, noting an absence of manual removal in claim 36 in contrast to claim 46, and an absence of manual removal in claim 17 in contrast to claim 50 and others.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exmr. Michael E. Butler whose telephone number is (571) 272-6937.

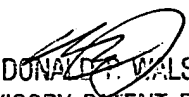
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh, can be reached on (571) 272-6944. The fax number for the Group is (703) 305-7687.



Michael E. Butler
Examiner

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SUPERVISORY PATENT EXAMINER
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